Applicant : Patrick Blattner et al.   Attorney's Docket No.: 06975-467001 / AOL 213
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REMARKS

With claims 69 and 70 having been previously canceled, claims 1-68 and 71-86 are pending in this application.

In the Office Action of February 13, 2008 ("Office Action"), claims 1-4, 7, 8, 18-32, 35-43, 47-55, 57, 58, 60-64, 66, 67 and 69-84 were rejected under 35 U.S.C. § 103 based on U.S. Patent No. 5,880,731 ("*Liles*") and U.S. Patent No. 6,910,186 B2 ("*Kim*"); claims 5, 6, 9-17, 56, 59, 65 and 68 were rejected under 35 U.S.C. § 103 based on *Liles*, *Kim* and WO 01/84461 A1 ("*Kim 461*"); claims 33 and 34 were rejected under 35 U.S.C. § 103 based on *Liles*, *Kim* and U.S. Patent No. 7,007,065 ("*Matsuda*"); and claims 44-46 were rejected under 35 U.S.C. § 103 based on *Liles*, *Kim* and U.S. Patent No. 7,177,811 ("*Ostermann*"). These rejections should be withdrawn for at least the following reasons.

Section 103 rejection based on *Liles* and *Kim*

Liles and *Kim* do not support a conclusion of obviousness with respect to claims 1-4, 7, 8, 18-32, 35-43, 47-55, 57, 58, 60-64, 66, 67 and 69-84.

Independent claim 1 recites a combination including:

> receiving, independent of the first user and the message, out-of-band information indicating a context of the first user; and

> communicating, based on stored data associations, the out-of-band information to the second user by changing an animation of the avatar representing the first user to graphically convey the context of the first user indicated by the received out-of-band information.

Liles and *Kim*, whether taken alone or in combination, fail to disclose or suggest at least these "receiving" and "communicating" features.

Liles discloses a system for communication between participants using graphical representations in a chat session where the participants may select a "gesture" with which to animate the participant's avatar. *See Liles*, col. 10, lines 33-45. *Liles* does not disclose or suggest at least the "receiving" and "communicating" features noted above. In fact, the Office Action acknowledges these deficiencies in *Liles*. *See* Office Action, p. 3.

Recognizing the deficiencies in *Liles*, the Office Action turns to *Kim*. *Kim* discloses communication through an organizational chat room, where a user can choose an emotion from a drop down list box to cause an avatar to express an "emotion." *See Kim*, col. 5, lines 45-50; col. 5, lines 62 – col. 6, line 12; col. 15, lines 54-62. On page 4, the Office Action asserts that *Kim* discloses "different behavior options for an avatar representing a user" and that "behavior options of the avatar (i.e. animated avatar) are received by other users in the virtual environment." As the basis for this assertion, the Office Action appears to rely upon the ability of the user, in *Kim*'s system, to select an "emotion" to be expressed by the avatar. *See Kim*, col. 15, lines 54-57. In so doing, the Office Action appears to equate the "emotion" taught by *Kim* with the out-of-band information of claim 1.

The out-of-band information of claim 1, however, is received independent of the first user and the message. On the other hand, the act of selecting the "emotion" required by *Kim*'s system would make the receiving of that information dependent on the user. Likewise, even if *Kim*'s system were to change an animation of an avatar, there is no disclosure regarding graphically conveying the context of a user that is indicated by out-of-band information received independent of the user and the message, as claimed. *Kim*, therefore, does not disclose or suggest receiving, independently of the first user and the message, out-of-band information related to a context of the first user and communicating, based on stored data associations, the out-of-band information to the second user by changing an animation of the avatar representing the first user to graphically convey the context of the first user indicated by the received out-of-band information, as claimed.

For at least the foregoing reasons, *Liles* and *Kim* fail to disclose or suggest each and every element recited in independent claim 1 and required by its dependent claims 2-4, 7, 8, 18-32, 35-43, 47-53, 76-78, 85 and 86. Moreover, no basis has been established for "concluding that it would have been obvious to one of ordinary skill in the art to bridge the gap." M.P.E.P. § 2143.01 (VI), 8th Ed., Rev. 6 (September 2007). Indeed, the applied references do not provide such a basis. The section 103 rejection of claim 1 and its dependent claims should accordingly be withdrawn.

Independent claim 54 recites a combination including:

> receive, independent of the first user and the message, out-of-band
> information indicating a context of the first user; and

> communicate, based on stored data associations, the out-of-band
> information to the second user by changing an animation of the
> avatar representing the first user to graphically convey the context
> of the first user indicated by the received out-of-band information.

Although claim 54 is different in scope from claim 1, the section 103 rejection of claim 54 and
its dependent claims 55, 57, 58, 60-62 and 79-81 based on *Liles* and *Kim* should be withdrawn
for at least reasons similar to those presented above in connection with claim 1.

Independent claim 63 recites a combination including:

> receive, independent of the first user and the message, out-of-band
> information indicating an activity of the first user; and

> communicate, based on stored data associations, the out-of-band
> information to the second user by animating the avatar to
> graphically perform the activity of the first user indicated by the
> received out-of-band information.

The Office Action rejects claim 63 under the "same rationale" as for claim 1. Office
Action, p. 10. Similar to claim 1, independent claim 63 recites that out-of-band information is
received "independent of the first user and the message" and communicated based on stored data
associations to the second user. In claim 63, the out-of-band information indicates "an activity
of the first user" and is communicated by animating the avatar to "graphically perform the
activity" of the first user. The specification provides an example consistent with such features:

> The sender avatar 135 also may communicate an activity being
> performed by the sender while the sender is using the instant
> messaging user interface 105. For example, when the sender is
> listening to music, the avatar 135 may appear to be wearing
> headphones. When the sender is working, the sender avatar 135
> may be dressed in business attire, such as appearing in a suit and a
> tie.

Specification, p. 12, lines 3-7.[1] Neither *Kim* nor *Liles*, nor any combination thereof, discloses or suggests these "receive" and "communicate" features of claim 63. On the contrary, as discussed above, receiving a user selection of an emotion as disclosed by *Kim* is not consistent with receiving information independent of the user and the message, as claimed.

Kim discloses various avatar behavior options, as noted in the Office Action (see page 4). But *Kim* does not disclose or suggest animating an avatar to perform an activity of a user represented by the avatar indicated in out-of-band information received independent of the user and the message, as recited in claim 63. Indeed, *Kim*'s behavior options are not activities of a user indicated by information received in out-of-band information, as claimed.

For at least the foregoing reasons, *Liles* and *Kim* fail to disclose or suggest each and every element recited in independent claim 63 and required by its dependent claims 64, 66, 67, 71 and 82-84. Moreover, no basis has been established for concluding that it would have been obvious to a skilled artisan to bridge the gap between these references and what is claimed. *See* M.P.E.P. § 2143.01 (VI). The section 103 rejection of claim 1 and its dependent claims should accordingly be withdrawn.

Similar to claim 63, independent claim 72 recites a combination including:

> receive, independent of the first user and the message, out-of-band information indicating an activity of the first user; and

> communicate, based on stored data associations, the out-of-band information to the second user by animating the avatar to graphically perform the activity of the first user indicated by the received out-of-band information.

Although claim 72 is different in scope from claim 63, the section 103 rejection of claim 72 and its dependent claims 73-75 based on *Liles* and *Kim* should be withdrawn for at least reasons similar to those presented above in connection with claim 63.

In rejecting dependent claims 74 and 75, the Office Action cites to *Tang* (U.S. Patent No. 6,349,327). However, this reference is not mentioned in the statement of rejection on page 3 of

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[1] The reference to the specification above is not intended to limit the scope of the claims to the exemplary implementations shown in the drawings and described in the specification. Rather, the entitlement to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law is expressly affirmed.

the Office Action. Furthermore, the Office Action fails to offer any a motivation or other basis for combining *Kim*, *Liles*, and *Tang* to support such a rejection. Should the Examiner continue to dispute the patentability of the claims, the next Office Action, which should not be final, should clarify the basis for rejection of claims 74 and 75.

Section 103 rejection based on *Liles, Kim* and *Kim 461*

In the Office Action, claims 5, 6, 9-17, 56, 65, and 68 stand rejected under section 103 based on *Kim*, *Liles*, and *Kim 461*. Claims 5, 6, 9-17, 56, 65, and 68 depend upon independent claims 1, 54 and 63. As discussed above, *Kim* and *Liles* fail to disclose or suggest each and every feature of independent claims 1, 54 and 63. *Kim 461*, which was applied to certain features of dependent claims 5, 6, 9-17, 56, 65, and 68, fails to cure the deficiencies of *Kim* and *Liles* with respect to independent claims 1, 54 and 63. Furthermore, no basis has been established for concluding that it would have been obvious to a skilled artisan to bridge the gap between the applied references and Applicants' claims. *See* M.P.E.P. § 2143.01(VI). Accordingly, *Kim*, *Liles* and *Kim 461*—whether taken alone or in any combination—fail to render obvious claims 1, 54 and 63 or their respective dependent claims 5, 6, 9-17, 56, 65, and 68. Withdrawal of the section 103 rejection and the timely allowance of dependent claims 5-6, 9-17, 56, 65 and 68 is therefore requested.

Section 103 rejection based on *Liles, Kim,* and *Matsuda*

In the Office Action, claims 33 and 34 were rejected under section 103 based on *Kim*, *Liles*, and *Matsuda*. Claims 33 and 34 depend upon independent claim 1. As discussed above, *Kim* and *Liles* fail to disclose or suggest each and every feature of independent claim 1. *Matsuda*, which was applied to certain features of claims 33 and 34, fails to cure the deficiencies of *Kim* and *Liles* with respect to independent claim 1. Furthermore, no basis has been established for concluding that it would have been obvious to a skilled artisan to bridge the gap between the applied references and the claims. *See* M.P.E.P. § 2143.01(VI). Accordingly, *Kim*, *Liles* and *Matsuda*—whether taken alone or in any combination—fail to render obvious claim 1

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or its dependent claims 33 and 34. The section 103 rejection and the timely allowance of dependent claims 33 and 34 is therefore requested.

Section 103 rejection based on *Liles*, *Kim*, and *Ostermann*

The Office Action rejected claims 44-46 under section 103 based on *Kim*, *Liles*, and *Ostermann*. Claims 44-46 ultimately depend upon claim 1. As discussed above, *Kim* and *Liles* fail to disclose or suggest each and every feature of independent claim 1. *Ostermann*, which was applied to certain features of claims 44-46, fails to cure the deficiencies of *Kim* and *Liles* with respect to the independent claim. Further, no basis has been established for concluding that it would have been obvious to a skilled artisan to bridge the gap between the applied references and what is claimed. *See* M.P.E.P. § 2143.01(VI). Accordingly, *Kim*, *Liles* and *Matsuda*— whether taken alone or in any combination—fail to render obvious claim 1 or its dependent claims 44-46. The section 103 rejection of claims 44-46 should therefore be withdrawn, and claims 44-46 should accordingly be allowed.

Conclusion

It is requested that the Examiner reconsider the application in view of the remarks and timely allow pending claims 1-68 and 71-86.

It is believed that all pending issues in the outstanding Office Action have been addressed by this paper. This Action, however, contains a number of statements reflecting characterizations of the related art and the claims. Whether or not any such statement is identified herein does not constitute an automatic subscription to any statement or characterization in the Office Action. In addition, there may be reasons for patentability of any or all pending or other claims that have not been expressed above.

If there are any questions regarding this paper or the application generally, a telephone call to the undersigned would be appreciated since this may expedite prosecution of the application.

It is hereby petitioned that the period for response to the Office Action be extended for two (2) months. The Petition for Extension of Time fee of $460.00 is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please grant any additional extensions of time required to enter this paper and apply any other required charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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